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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,289	10/29/1999	KEITH R. D'ALESSIO	100497.02	7047

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ALEXANDRIA, VA 22320

EXAMINER

HON, SOW FUN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/24/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

# Office Action Summary

Application No.

09/430,289

Applicant(s)

D'ALESSIO ET AL.

Examiner

Sow-Fun Hon

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 21-44, 51-55, 57-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 45-50, 56 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

***Election/Restrictions***

1. Applicant's election with traverse of claims 1-20, 45-50, 56, 59 in Paper No. 15 is acknowledged. The traversal is on the ground(s) that the claims are drawn to sufficiently inter-related inventions to warrant examination thereof in a single application. This is not found persuasive because the restriction was made because the polymeric material on said internal surface of container can be halogenated before being coated onto the the container, a materially different process.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant is correct on the rejoinder of the process claims containing all the limitations of the allowed product claims. However, rejoinder is premature at this point.

***Withdrawn Rejections***

3. The 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection in Paper # 11, paragraph 7 (mailed 07/06/01) of claims 10-11 has been withdrawn due to Applicant's clarification in Paper # 15 (filed 11/06/01). The broad interpretation of the limitation "shelf life" has been affirmed.

4. The 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection in Paper # 11, paragraph 9 (mailed 07/06/01) of claim 18 has been withdrawn due to Applicant's clarification in Paper # 15 (filed 11/06/01). The broad interpretation of the limitation "halogen concentration .. is greater than .." has been affirmed.

***Rejections Repeated***

5. The 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection of claims 6-8, 15 has been repeated for the same reasons previously of record in Paper # 11, paragraph 8 (mailed 07/06/01). The reference cited by Applicant does not clearly define the different types of polyethylene in terms of density.

6. The 35 U.S.C. 103(a) rejection of claims 1-4, 9, 13-14, 45-46 over Colvin et al. has been repeated for the same reasons previously of record in Paper # 11, paragraph 11 (mailed 07/06/01).

7. The 35 U.S.C. 103(a) rejection of claims 5-6, 8, 10-12, 15, 18-20, 56, 59 over Colvin et al. in view of McIntire et al. and Stehlik has been repeated for the same reasons previously of record in Paper # 11, paragraph 11(a) (mailed 07/06/01).

8. The 35 U.S.C. 103(a) rejection of claims 7, 47 over Colvin et al. in view of Kvitrud et al. has been repeated for the same reasons previously of record in Paper # 11, paragraph 12 (mailed 07/06/01).

9. The 35 U.S.C. 103(a) rejection of claims 47-50 over Colvin et al. in view of Larson et al. has been repeated for the same reasons previously of record in Paper # 11, paragraph 13 (mailed 07/06/01).

***Response to Arguments***

10. Applicant's arguments in Paper # 15 (filed 11/06/01) have been fully considered but they are not persuasive.

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11. Applicant argues that Colvin does not teach or suggest post-halogenated or functionalized materials. Applicant is respectfully reminded that even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, although Applicant states that the materials and containers are different from those of Colvin et al., Applicant has failed to show the difference in terms of composition or its corresponding physical properties.

Applicant's argument that the surface energy of Applicant's post-halogenated surface is actually higher than the surface energy of the fluorinated polymers taught by Colvin et al. should be supported by actual comparative data. In addition, Applicant is respectfully requested to clarify whether the surface fluorination is conducted in the presence of oxygen. With the absence of oxygen in the fluorine/nitrogen gas mixture, the surface becomes highly hydrophobic and the fluorinated materials show remarkable barrier properties. With the presence of oxygen in the fluorine/nitrogen gas mixture, the surface wettability increases due to the introduction of polar groups and the treated surfaces show excellent adhesive properties (Alkor, pages 1-2).

12. With regards to Applicant's argument that the presence of residual halogen acid in the container matrix is not present in containers made from prehalogenated materials, Applicant is respectfully advised that the feature upon which applicant relies (i.e., the amount of residual halogen acid) is not recited in the rejected claim(s). Although the claims are interpreted in light

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of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. With regards to the valid use of McIntire et al. as a secondary reference, McIntire et al. teaches that inclusion of the acid dispersed in the moldable materials inhibits the polymerization of the cyanoacrylates, thus providing the motivation to combine with the primary reference Colvin et al.

14. With regards to the valid use of Stehlik as a secondary reference, Stehlik teaches a process for sterilization of the cyanoacrylates using the specific claimed Lewis acid inhibitor of hydrogen fluoride, thus providing the motivation to combine with the primary reference Colvin et al.

15. With regards to the valid use of Kvidtrud et al. as a secondary reference, Kvidtrud et al. merely demonstrate that HDPE and PET are well known in the art as suitable hydrocarbon polymers for making cyanoacrylate dispensers, thus providing the motivation to combine with the primary reference Colvin et al.

16. With regards to the valid use of Larson et al. as a secondary reference, Larson et al. teaches that the claimed functional groups impart low surface energy to polymers, thus providing the motivation to combine with the primary reference Colvin et al. which teaches the desirability of low surface energies of the materials.

***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (703)308-3265. The examiner can normally be reached Monday to Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (703)308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

SH  
01/18/02

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

1/23/02